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PATENT
2569-0103P

IN RE APPLICATION OF BEFORE THE BOARD OF APPEALS

Wells OBRECHT

Appeal No.:

Conf.: 8032

Appl. No.: 08/900,360

Group: 2765

Filed: July 25, 1997

Examiner: MEINECKE DIAZ, S.

For: METHOD AND APPARATUS FOR PROCURING
GOODS IN AN AUTOMATED MANNER

REPLY BRIEF UNDER THE PROVISIONS OF 37 CFR 41

Assistant Commissioner for Patents
Washington, D.C. 20231

October 7, 2004

Sir:

This Reply Brief is in response to the Examiner's Answer dated August 9, 2004. This Reply Brief is limited to new points of arguments raised in the Examiner's Answer.

Only one copy of this Reply Brief is submitted as it is filed after the date (September 13, 2004) of the new rules.

Status of Amendments

An amendment was filed June 17, 2004 which stands entered.

An amendment was filed under the provisions of MPEP 1207 on September 8, 2004. This amendment was to correct punctuation in claim

17 by adding appropriate commas. It is assumed that this amendment will be entered as it was filed before the new Board Rules effective on September 13, 2004. If it is not, when this application is ready for issue, the Examiner is authorized to make these punctuation changes by unofficial Examiner's Amendment.

Grounds of Rejection

In Section 10 of the Examiner's Answer, some of the grounds of rejection set forth in the final Office Action of December 5, 2003 were repeated. It is noted in the art rejection in interpreting the claims, the Examiner uses the phrase "one seller". This phrase was changed to "two sellers" in the entered amendment filed on June 17, 2004.

The Examiner's position is understood, but not agreed to, accordingly it is not considered that any further action on the part of the Examiner is necessary. The Applicant's remarks regarding the rejection are set forth in the Brief and will not, of course, be repeated here.

Grouping of Claims

In Section 7 of the Examiner's Answer, the Examiner stated as follows:

The Appellant's statement in the Brief that certain claims do not stand or fall together is not agreed with because, while Appellant lists five separate groupings, Appellant argues the same basic argument as applicable to all of claims 1-20. Therefore, claims 1-20 are constructively interpreted as standing or falling together in one group.

The Examiner's statement regarding the grouping of claims is traversed. First of all, what does "constructively interpreted" mean legally? It is submitted that in the Brief, there were specific reasons set forth why the separately grouped claims did not stand or fall together. It was submitted that the separately grouped claims complied with 37 CFR 1.192 and the case of *In re Beaver* as set forth in Section VII of the Brief.

In summary, not only were the additional structure or steps of the claims set forth, but legal reasons were given why the references did not suggest what has been claimed in the separately grouped claims. Additionally, the Examiner's answer from page 20-23 does rebut the Applicant's position with respect to claims other than claim 1.

In the file history of this application, the Examiner previously had set forth that the grouping of claims was not proper. This was summarized in the Board's decision dated September 25, 2003 wherein the Board stated as follows:

As a final commentary, we take note of the fact that Appellant filed a petition on July 3, 2001 under 37 CFR 1.181(a) taking issue with the Examiner's position in the Answer that separate arguments for patentability of the appealed claims were not presented and therefore "... claims 1-20 stand or fall together." In a decision by John J. Love, Director of Technology Center 2100, mailed March 27, 2002, the petition was denied indicating that the issue of the grouping of claims is an appealable issue and not proper subject matter for petition. We would point out, as also discussed in the decision on the petition, that, despite the Examiner's position on the grouping of claims, the Examiner did in fact treat all claims that were separately argued in the Brief.

Accordingly, it is understood that grouping of claims is an issue to be left to the Board's decision.

Response to Arguments in Section 11 of the Examiner's Answer

With respect to the rejection of claim 17 and 18 under 35 USC 112, Second Paragraph, the only claims that still are rejected under 35 USC 112, the Appellant withdraws his traverse of this rejection based on the fact that claim 17 has been amended.

In any case when this application is allowed the Examiner may insert the commas in claim 17 by unofficial Examiner's Amendment.

Argument as to the Rejection Under 35 USC 101

First, it is the Appellant's position that there was no good and sufficient reason provided why this rejection under 35 USC 101 was now made. The Examiner stated that this issue was never presented before the Board and was therefore not considered during Appellant's previous appeal. This is found on page 15, first full paragraph, last sentence of the Answer.

Quite clearly, the Board of Appeals did have the authority to make a rejection under 35 USC 101 as explained in 37 CFR 1.196. The Board's nonaction regarding a rejection under 35 USC 101 is circumstantial evidence that the Board in considering the claims (1 and 2) considered them proper under 35 USC 101.

The Examiner on page 16, last line relies on MPEP 2106 (II)(A) but a fair reading of this portion of the MPEP clearly indicates that claims 1

and 2 provide “useful, concrete and tangible result”. The Examiner asserts that “Appellant continues to argue that there is no technological arts requirement under 35 USC 101...(Examiner’s Answer page 15, last paragraph, part of first sentence).

This was not the undersigned’s argument. The undersigned was relying on the *State Street* case (cited in the Brief). Also it was the undersigned’s position that claims 1 and 2 accomplish a useful application. In any case, the Examiner has again failed to define “technological”. This was discussed in the Brief page 8, lines 15-19.

Reply to Arguments Regarding the Rejection Under 35 USC 103

On page 20, line 11 of the Examiner’s Answer, the Examiner sets forth arguments in support of the rejection under 35 USC 103. One new point the Examiner argues that “car bargains must have some predetermined understanding of which dealers are to be contacted in the first place, thereby addressing the claim limitation in question”. (Answer page 21 lines 10-12). (emphasis added)

The statement of “predetermined understanding” first of all does not address the claim limitation which in the broadest claim has the phrase “predetermined group of sellers”. In explaining the position regarding “predetermined understanding” the Examiner uses an example of a Mustang convertible in the Washington, D.C. area. Actually, when the “personal shopper” receives a request from a client for the “Mustang convertible” while he may know that a Mustang is a Ford product it is

not necessary for the personal shopper to have a “predetermined understanding” or “a predetermined group of sellers”. What the personal shopper in all likelihood would do is to await the morning publication for example of the Washington Post, go to the car section and look up the automobile directory which does list car dealers under the heading of what cars they sell. Then the personal shopper could call the particular car dealers to find out the information. This clearly does not require a predetermined step as claimed and the Examiner’s assertion is the epitome of speculation.

Also, in answer to the Appellant’s argument with respect to claim 2, the Examiner asserts that “Appellant provides no support for this assertion” page 21, line 15 of the Answer. Here, the Examiner is answering the Appellant’s statement that there was no motivating reason to provide the combination in claim 2.

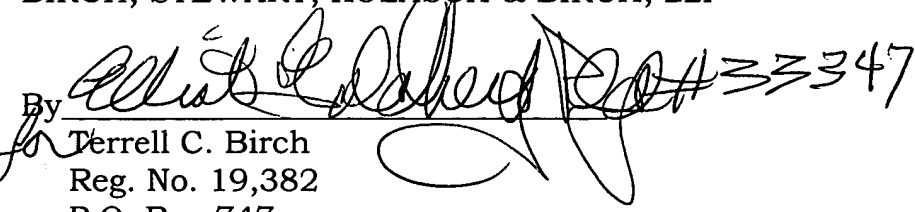
Initially, it is the duty of the Examiner to provide an explanation of the motivation. But, to answer the Examiner’s question it is submitted that the only motivation would be from the Appellant’s own disclosure. This is not a valid reason for providing motivation. In fact, the Examiner’s rejection regarding the use of different elements is not supported. This was set forth in the citation of *Hybritech Inc. v. Monoclonal Antibodies, Inc.* (cited in the Brief, page 11, line 5).

For the convenience of the Board, a copy of the appealed claims including the amendment to claim 17 is enclosed as Appendix A. For the

reasons set forth in the Brief and the Reply Brief it is requested that the rejections set forth by the Examiner be reversed.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #33347
Terrell C. Birch
Reg. No. 19,382
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

TCB/EAG/jm
2569-103P

APPENDIX A

Claims

Claim 1

A method for purchasing goods or services from a seller by a buyer comprising:

(a) receiving a request from a buyer for goods or services

with a predetermined plurality of criteria related to the goods or services;

(b) selecting at least two sellers from a predetermined group

of sellers of the goods or services based on the received predetermined plurality of criteria;

(c) transmitting the request of the buyer to the selected at least two sellers of the goods or services;

(d) receiving, within a predetermined time interval, responses from the at least two sellers to the request;

(e) compiling information provided in the responses received from at least one seller within the predetermined time interval;

(f) ranking the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking; and

(g) providing the compiled responses of the selected sellers for access by the buyer.

Claim 2

The method of claim 1, wherein in (a), a computer receives the request.

Claim 3

The method of claim 2, wherein in (b), selecting is performed by a central computer.

Claim 4

The method of claim 3, wherein in (c), transmitting is done by an internet system.

Claim 5

The method of claim 4, wherein in (d), receiving is done by the central computer.

Claim 6

The method of claim 5, wherein in (e) and (f), the compiling and ranking is performed by the central computer.

Claim 7

The method of claim 6, wherein in (g), accessing by the buyer is performed by an internet connection.

Claim 8

The method of claim 7, wherein the goods are selected from the group consisting of vehicles, computers, or appliances and the services are selected from the groups consisting of legal, financing, medical, or insurance.

Claim 9

The method according to claim 8, wherein the goods are vehicles.

Claim 10

A system for obtaining information for the purchasing of goods or services comprising:

input means for receiving a request for desired goods or services from a buyer, the request including predetermined criteria related to the goods or services;

selection means for selecting at least two providers from a predetermined group of providers of the goods or services based on the predetermined criteria;

transmission means for transmitting the request of the buyer to the selected providers;

reception means for receiving, within a predetermined time interval, response from the selected providers;

computation means for compiling information provided in the response received within the predetermined time interval for ranking the sellers based upon the compiled information, and for selecting sellers with the relatively highest ranking; and

output means for providing the compiled responses of the selected sellers for access by the buyer.

Claim 11

The system according to claim 10, wherein the input means is a computer.

Claim 12

The system according to claim 11, wherein the selection means is a central computer.

Claim 13

The system according to claim 12, wherein the transmission means includes an internet system.

Claim 14

The system according to claim 13, wherein the reception means includes a central computer.

Claim 15

The system according to claim 14, wherein the computation means includes the central computer.

Claim 16

The system according to claim 14, wherein the output means includes an internet connection.

Claim 17

The system of claim 16, wherein the goods are selected from the group consisting of vehicles, computers, or appliances.

Claim 18

The system according to claim 17, wherein the goods are vehicles.

Claim 19

A system for obtaining information for the purchasing of automobiles by prospective buyers comprising:

input means, including a computer, for receiving a request for a desired automobile from a prospective buyer, the request including plurality of predetermined criteria related to the automobile;

selection means, including central computer, for selecting at least two providers from a predetermined group of providers of the automobile based on the plurality of predetermined criteria;

transmission means, including an internet connection, for transmitting the request for the prospective buyer to the selected providers;

reception means, including the central computer, for receiving, within a predetermined time interval, responses from the selected providers;

computation means, including the central computer, for compiling information provided in the response received within the predetermined time interval for ranking the providers based upon the compiled information including the plurality of criteria, and for selecting providers with the relatively highest ranking; and

output means, including an internet connection, for providing the compiled responses of the selected providers for access by the prospective buyer.

Claim 20

The system of claim 19, wherein the automobile is a previously owned automobile.